

Applicants : Donal O'Shea et al.
Serial No. : 10/508,754
Page : 7

REMARKS

In response to the Office Action dated October 18, 2005, Applicants herewith submit a Petition for a two-month extension of time along with a check in the amount of \$225 (small entity) to cover the required fee.

Claims 15-34 were pending in the application. Claims 1-14 had previously been cancelled in the Preliminary Amendment filed September 22, 2004. Applicants herein request cancellation of Claims 15-26 without prejudice and without disclaimer as to the subject matter thereof. Applicants herein add new Claims 35 and 36 to define one embodiment of the invention, in which the chelating agent is defined as comprising BX_2 , wherein each X is independently a halide. Claims 27-36 are now pending in the application.

In the Office Action, the Examiner has suggested that there are at least six inventions and has sought election/restriction to one invention. Applicants respectfully traverse the restriction and election requirement and lack of unity of invention objection.

Favorable reconsideration of the lack of unity of invention objection and allowance of all of the claims in the present application are respectfully requested in view of the following comments.

The Examiner has raised a unity of invention objection by stating that the claims are not so linked as to form a single inventive concept under PCT Rule 13.1. The subject application is, as the Examiner is aware, a 371 out of a PCT application. During the International phase, the PCT Search Examiner did not raise a unity of invention objection under PCT Rule 13.1. Applicants have now received an examination report on the corresponding European application and, again, the European Examiner has not raised a unity of invention objection.

Applicants have now cancelled Claims 15-26 to the compound without prejudice and respectfully traverse the restriction by submitting that Applicants do meet the unity of invention criteria with Claims 27-36. Specifically, there are now 4 independent claims directed to a pharmaceutical composition and its method of use. Claims 27 and 35 are directed to pharmaceutical compositions useful in photodynamic therapy comprising a compound, in association with a pharmaceutically acceptable diluent or carrier, the compound having as a common structural feature, two pyrrole rings linked by a nitrogen (an azadipyrromethene) and Claims 31 and 36 are directed to a method of treating a

Applicants : Donal O'Shea et al.
Serial No. : 10/508,754
Page : 8

photosensitive target biological cell *in vivo* or *in vitro*, the method comprising contacting the target biological cell with an effective amount of a compound having the same common structural feature, namely, two pyrrole rings linked by a nitrogen (an azadipyrromethene). In addition to sharing the common structural feature of an azadipyrromethene entity, all of the independent claims share the features of including a chelator and having activity in treating photosensitive conditions.

The Examiner would appear to be relying on Japanese Patent Publication No. 11092479 (Takuma) to support his arguments that the common structural feature of the azadipyrromethene entity fails to define a contribution over the prior art. Applicants submit that Takuma neither discloses or suggests any utility for any compounds disclosed in Takuma as either pharmaceutical compositions or methods of treating a photosensitive target biological cell *in vivo* or *in vitro*. Instead, Takuma concerns itself with optical recording media and the problem of allowing the recording and reproduction with short wavelength laser and suitable for high-density recording. Therefore, Takuma does not support a lack of unity of invention for Claims 27-36 and it is respectfully submitted that they should be examined together in this application.

In order to ensure that this reply to the Office Action is complete, Applicants hereby provisionally elect the following single group and have provided an exemplary single embodiment for continued search and respectfully submit that all of the current claims should be examined together and allowed.

Specifically, Applicants provisionally elect the group in which M is BX_2 , where X is a halogen, R^1 , R^3 , R^4 and R^6 are all substituted or unsubstituted, saturated or unsaturated, cyclic or heterocyclic moieties, e.g., an aryl, cyclic moiety such as an optionally substituted phenyl, and R^2 and R^5 are independently a water solubilizing group or a heavy atom such as a halogen. Applicants hereby provisionally provide an exemplary single embodiment of this group for continued searching and examination, namely, a compound in which M is BF_2 ; R^2 and R^5 are each Br; R^3 and R^4 are each phenyl; and R^1 and R^6 are each *p*-methoxyphenyl. This is described as compound 4b in the paragraph bridging pages 15 and 16 of the specification as originally filed.

Applicants herewith file a Supplemental Information Disclosure Statement to bring to the Examiner's attention a citation recently brought to Applicants' attention in an

Applicants : Donal O'Shea et al.
Serial No. : 10/508,754
Page : 9

examination report dated December 23, 2005, on the corresponding European application.

The citation is European Patent Publication No. 1 253 151.

Applicants respectfully request that all of the current Claims 27-36 be examined and allowed.

Respectfully submitted,

DONAL O'SHEA ET AL.

By: Van Dyke, Gardner, Linn & Burkhart, LLP

1/18/06
Date

Donald S. Gardner
Donald S. Gardner
Reg. No. 25 975
Van Dyke, Gardner, Linn & Burkhart, LLP
2851 Charlevoix Drive, S.E.
P.O. Box 888695
Grand Rapids, MI 49588-8695
(616) 975-5502

DSG/ram